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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,571	04/24/2001	Shinji Tsujio	A32701-A -072561.0154	6832

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EXAMINER

SHOSHO, CALLIE E

ART UNIT PAPER NUMBER

1714

1D

DATE MAILED: 05/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/841,571	TSUJIO, SHINJI
	Examiner Callie E. Shosho	Art Unit 1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 January 2002.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 4-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 and 4-15 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6</u> .	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

1. All outstanding rejections except for those described below are overcome by applicant's amendment filed 1/24/02.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 14-15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Newly added claim 14 recites that "the content of the film forming resin in said ink composition is not more than 25% by weight". It is the examiner's position that the cited phrase fails to satisfy the written description requirement under the cited statute since there does not appear to be a written description requirement of the phrase "the content of the film forming resin in said ink composition is not more than 25% by weight" in the application as originally filed. In re Wright, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163.

Page 11, lines 1-2 of the present specification discloses that the film forming resin is present in an amount of 10-30%, preferably, 15-25%. However, this does not provide support for the claimed amount of "not more than 25%" which includes amounts of film forming resin of less than 10% for which there is no support in the present specification.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1, 4, and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshioka et al. (U.S. 5,621,021).

The rejection is adequately set forth in paragraph 6 of the office action mailed 7/24/01, Paper No. 4, and is incorporated here by reference.

Additionally, with respect to new claim 14, it is noted that col.2, lines 35-36 of Yoshioka et al. disclose that the ink composition contains 2-50%, preferably, 20-30% film forming resin

6. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshioka et al. as applied to claims 1, 4, and 11-15 above, and further in view of either Enami (U.S. 4,471,079) or Koyama (U.S. 5,977,211).

The rejection is adequately set forth in paragraph 7 of the office action mailed 7/24/01, Paper No. 4, and is incorporated here by reference.

7. Claims 1, 4, 9-11, and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uzukawa et al. (U.S. 5,120,359) in view of Yoshioka et al. (U.S. 5,621,021).

The rejection is adequately set forth in paragraph 8 of the office action mailed 7/24/01, Paper No. 4, and is incorporated here by reference.

Additionally, with respect to new claim 14, it is noted that col.1, lines 37-38 of Uzukawa et al. disclose that the ink composition contains 3-50%, preferably, film forming resin

8. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uzukawa et al. in view of Yoshioka et al. as applied to claims 1, 4, 9-11, and 13-15 above, and further in view of either Enami (U.S. 4,471,079) or Koyama (U.S. 5,977,211).

The rejection is adequately set forth in paragraph 9 of the office action mailed 7/24/01, Paper No. 4, and is incorporated here by reference.

Response to Arguments

9. Applicant's arguments filed 1/24/02 have been fully considered but they are not persuasive.

Specifically, applicant argues that:

- (a) Yoshioka et al. do not disclose or suggest a size distribution as presently claimed.
- (b) The ink of Koyama et al. requires large amounts of film forming resin that fall outside the scope of the present claims.
- (c) Enami discloses the use of dyes with particle size less than 2 μm .

With respect to argument (a), it is noted that the present claims require that the colorant has mean particle size of 2-7 μm wherein particles having a size of not more than 1.8 μm account for not more than 1.6% by weight of the colorant and wherein particles having size of not less

than 7 μm account for not more than 0.5% by weight of the colorant. Given the claim language, i.e. "not more than 1.6%" and not more than 0.5%", it is clear that in one embodiment, the present claims encompass colorant which has mean particle size of 2-7 μm with 0% of the particles having a size of not more than 1.8 μm and 0% of the particles having size of not less than 7 μm . That is, there are no particles present that have particle size less than 2 μm or greater than 7 μm .

Given that Yoshioka et al. disclose colorant that has particle diameter of 2-5 μm or colorant that has particle diameter of 2-3 μm , it is clear that Yoshioka et al. meet the above-described requirements of the present claims.

Applicants also argue that the ink of examples 1 and 2 of Yoshioka et al. require 25% film forming resin while the ink of the present invention only requires 20% film forming resin as evidenced by example 4 of the present specification. However, it is noted that with the exception of newly added claim 14, there is no requirement in the present claims regarding the amount of film forming resin. Further, given that claim 14 requires that the ink contain not more than 25% film forming resin and Yoshioka et al. disclose that the film forming resin is present in an amount of 2-50%, preferably, 20-30% (col.2, lines 35-36), it is clear that Yoshioka et al. meets the limitation of present claim 14.

Applicants have also submitted a declaration wherein ink within the scope of the present claims, i.e. wherein colorant has mean particle size of 2.5-4 μm and particles having a size of not more than 1.8 μm account for 0% by weight and particles having a size not less than 7 μm account for 0% by weight, is compared with ink outside the scope of the present claims, i.e.

wherein colorant has particle size of 0.3-8.5 μm and particles having a size of not more than 2 mm account for 20% by weight and particles having a size not less than 7 μm account for 1% by weight. It is shown that the ink of the present invention has superior erasability.

However, it is the examiner's position that this data is not successful in establishing unexpected or surprising results because the data in the declaration does not compare the ink of the present invention with the ink of the "closest" prior art Yoshioka et al. That is, the ink of comparative example A contains colorant which has particle size of 0.3-8.5 μm and particles having a size of not more than 2 μm account for 20% by weight and particles having a size not less than 7 μm account for 1% by weight. However, the colorant of Yoshioka et al. has particle diameter of 2-5 μm or 2-3 μm and thus does not have particle size outside the scope of the present claims or appear to contain any particles having a size of not more than 2 μm and not less than 7 μm . Thus, the colorant disclosed by Yoshioka et al. is closer to the present invention than that of comparative example A.

Further, given that the ink of the present invention disclosed in the declaration (example A) contains colorant with particle size of 2.5-4 μm with no particles having a size of not more than 1.8 μm and not less than 7 μm and given that Yoshioka et al. disclose ink with particle diameter of either 2-5 μm or 2-3 μm , it appears that the ink of Yoshioka et al. is the same as the inventive ink of the declaration and thus, would intrinsically possess the same erasability as described in the declaration. What is the difference between the ink of example A in the declaration and the ink of Yoshioka et al.? Clarification is requested.

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With respect to argument (b), firstly, it is noted that with the exception of newly added claim 14, there is no requirement in the present claims regarding the amount of film forming resin. Further, given that claim 14 requires that the ink contain not more than 25% film forming resin and Koyama et al. disclose that the film forming resin is present in an amount of 2-50%, preferably, 20-30% (col.2, lines 56-58), it is clear that Koyama et al. meets the limitation of present claim 14.

With respect to argument (c), while it is not clear where Enami states that the dyes have particle size less than 2 μm , nevertheless, it is noted that Enami is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely the use of polysaccharide in erasable ink compositions, and in combination with the primary reference, discloses the presently claimed invention. If the secondary reference contained all the features of the present claimed invention, it would be identical to the present claimed invention, and there would be no need for secondary references.

Information Disclosure Statement

10. It is noted that all references have been stricken from the IDS mailed 10/31/01, Paper No. 6, since they have all been cited on the PTO-892 attached to the office action mailed 7/24/01.

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Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

CS.

Callie Shosho
May 2, 2002

Vas Jagannathan
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